

### **REMARKS**

Claims 1-15 were pending at the time of the Office action. Claims 12-15 have been canceled as pertaining to an unelected invention by the amendment filed August 16, 2005. Claims 1-11 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Further, Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent 4,858,504 to Tsai.

A. **Rejection under 35 U.S.C. § 112, Second Paragraph**

Claims 1 and 8 are currently amended to remove the phrase "screwdriver style" from the preamble in response to the Examiner's observations. Applicant submits that without the phrase "screwdriver style," claims 1-11 are not indefinite and satisfy the requirement of 35 U.S.C. § 112, second paragraph.

B. **Rejection under 35 U.S.C. § 103(a)**

Claim 1 is currently amended to include the limitation of original claim 2. Consequently, original claim 2 is canceled, and claim 3 is amended to make claim 3 dependent on claim 1.

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent 4,858,504 to Tsai. The Examiner asserts that it would be obvious to create the present invention in light of Tsai. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Tsai teaches a screwdriver with an insulated shaft comprising a shaft with a polygonal end; an insulated block having a polygonal recess that receives the polygonal end; a polygonal head having a recess that receives the insulated block; and a handle having a centrally axial cylindrical opening to receive the shaft, insulated block and polygonal head. Tsai requires a polygonal head because the purpose of the invention is to obviate a drawback of a conventional screwdriver that an operator cannot use a wrench to drive the conventional screwdriver. See Tsai, column 1, lines 13-26.

The present invention, as embodied in amended claims 1 and 8 (as well as new claim 16), require the impact cap to be in contact with the shank of the pry bar. This requires a metal-to-metal contact to transfer the force impacted on the cap directly to and through the shank. To compare Tsai to the present invention, Tsai would have to be modified at least by removing an insulated block described in column 2, lines 3-10, and eliminating the gap between the polygonal head and the shaft.

Applicant asserts that it would not be obvious from the teaching of Tsai to remove the insulated block. In fact, removing the insulated block would be contrary to the teaching of Tsai, as the insulated block is an essential element. In column 2, lines 23-27, Tsai teaches the importance of the insulated block. The insulated block prevents an operator from being injured by electric shock when the operator uses a wrench to drive the polygonal head.

Understanding the purpose of the Tsai invention, there is no motivation to remove the insulating block. The insulating block is integral to the safety of the Tsai invention. See column 2, lines 23-27.

Further, without the insulating block, there is not a reasonable chance of successfully having an insulated screwdriver under Tsai. As the Examiner Noticed, insulating materials can be plastic. To achieve the insulating function without the insulating block, the Tsai polygonal head could be plastic. However, as the Examiner further Noticed, many impact-receiving applications are made from metal because of the superior impact strength of metal. Therefore, there is not a reasonable expectation of success of having a capable, insulated screwdriver under Tsai if the insulating block were removed and the polygonal head were plastic.

Because the examiner has not shown any motivation to remove the insulated block, and the Tsai patent teaches away from removing the insulated block, and there is not a reasonable expectation of success of the Tsai screwdriver without the insulating block, Applicant respectfully asserts that the Examiner has not made out a *prima facie* case of obviousness.

#### C. New Claims

Claims 16-21 are new by this amendment. No new matter has been added.

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Amdt. dated September 19, 2005  
Reply to Office action of September 9, 2005

Prompt consideration of this application and allowance of the claims are requested. If the Examiner should have any question regarding this application or the amendment, a call to Applicant's attorney would be appreciated.

Respectfully submitted,

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